



P23568.A08

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : S. SCHRAGA Confirmation No. 8544
Serial No : 10/641,142 Group Art Unit: 3731
Filed : August 15, 2003 Examiner: M. H. Thaler
For : ADJUSTABLE LANCET DEVICE AND METHOD

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314
Sir:

This request is being filed concurrently with a Notice of Appeal and is responsive to the Final Official Action of November 28, 2005.

Reconsideration and withdrawal of the 35 U.S.C. § 112, 2nd Paragraph rejection and the 35 U.S.C. §§ 102(b) and 103(a) rejections is respectfully requested in view of the following remarks.

A prima facie case of indefiniteness has not been set forth and the Rejection under 35 U.S.C. § 112, 2nd Paragraph Is Improper

A prima facie case of unpatentability has not been set forth and the Rejections Under 35 U.S.C. §§ 102(b) and 103(a) Are Improper

Examiner's Assertion

On page 3 of the Final Office Action, the Examiner asserts that claims 1-3 and 8-42 are indefinite because claim 1 recites that the second stop surface FSS extends inwardly from the body when in fact that this stop surface is shown in the drawings and described in the specification as being part of the body.

Applicant's Response

Applicant disagrees that the noted claim feature is confusing. There is no

contradiction between the second stop surface FSS extending inwardly from the body (which is in fact shown in the drawings) and this stop surface being either integrally formed with the body (as is shown in e.g., Figs. 3 and 36) or formed on a separate part (see e.g., Fig. 17). In each of the disclosed embodiments, the second stop surface does in fact extend inwardly from the body, and the Examiner has not demonstrated otherwise. Applicant respectfully reminds the Examiner that Applicant is not required to limit the invention to only the preferred embodiments disclosed in the specification.

Examiner's Assertion

On pages 3 and 4 of the Final Office Action, the Examiner asserts that claims 1-3, 8-23, 27-31 and 37-42 are anticipated or rendered obvious by SCHRAGA (US 6,156,051).

Applicant's Response

Applicant respectfully disagrees. Claim 1 recites a second stop surface that is non-movably coupled to the body and that at least partial rotation of the front cover causes the skin engaging end to move axially relative to the second stop surface. SCHRAGA does not disclose, or even suggest, these features.

The Examiner has identified the second stop surface in SCHRAGA as the lower surface of member 174 in Fig. 16. However, the Examiner has apparently failed to appreciate that member 174 is part of member 20C which is threadably and movably connected to the body 20A via threads 170/172 (see col. 14, lines 17-35). Thus, the Examiner is not correct that member 174 is non-movably coupled to the body. Furthermore, while the Examiner has asserted that partial rotation of cover 50 causes the skin engaging end to move axially relative to the second stop surface, and identified col. 14, lines 21-24 of SCHRAGA as disclosing this feature, the Examiner has failed to appreciate that because the cover 50 has a triangular cross-section and slides onto a triangular portion of the body 20, it cannot possibly rotate relative to the body 20. Additionally, as col. 14, lines 21-24 of SCHRAGA merely discusses the adjustability of the upper housing 20A relative to the middle housing 20C, the Examiner cannot reasonably argue that either of these parts is a front cover. Applicant respectfully reminds the

P23568.A08

Examiner that the front cover recited in claim 1 is defined as having a skin engaging end that includes a lancet opening through which a lancet needle may extend. Neither of the body portions 20A and 20C include this feature.

Examiner's Assertion

On pages 4 and 5 of the Final Office Action, the Examiner asserts that claims 24-26 and 32-35 are rendered obvious by SCHRAGA (US 6,156,051) alone.

Applicant's Response

Applicant respectfully disagrees. Again, claim 1 recites a second stop surface that is non-movably coupled to the body and that at least partial rotation of the front cover causes the skin engaging end to move axially relative to the second stop surface. This feature is not disclosed or suggested by SCHRAGA.

As explained above, while the Examiner has identified the second stop surface in SCHRAGA as the lower surface of member 174 in Fig. 16, the Examiner has failed to appreciate that member 174 is part of member 20C which is threadably and movably connected to the body 20A via threads 170/172 (see col. 14, lines 17-35). Thus, the Examiner is not correct that member 174 is non-movably coupled to the body. Again, while the Examiner has asserted that partial rotation of cover 50 causes the skin engaging end to move axially relative to the second stop surface, and identified col. 14, lines 21-24 of SCHRAGA as disclosing this feature, the Examiner has failed to appreciate that because the cover 50 has a triangular cross-section and slides onto a triangular portion of the body 20, it cannot possibly rotate relative to the body 20. Furthermore, as col. 14, lines 21-24 of SCHRAGA merely discusses the adjustability of the upper housing 20A relative to the middle housing 20C, the Examiner cannot reasonably argue that either of these parts is a front cover. Applicant respectfully reminds the Examiner that the front cover recited in claim 1 is defined as having a skin engaging end that includes a lancet opening through which a lancet needle may extend. Neither of the body portions 20A and 20C include this feature.

Examiner's Assertion

On pages 5 and 6 of the Final Office Action, the Examiner asserts that claims 43 and 44 are rendered obvious by the combination of SLAMA (US4,469,110) and SCHRAGA (US 6,156,051).

Applicant's Response

Applicant respectfully disagrees. Claim 43 recites a main spring disposed between the front and rear ends of the holding member and a second stop surface axially retained to a front portion of the body. Furthermore, claim 44 recites a back cap configured to move the holding member to a retracted position, a second spring disposed between the rear end of the holding member and a surface of the back cap, and a second stop surface axially retained to a front portion of the body.

Applicant acknowledges that SLAMA discloses a lancet device which utilizes, among other things, a body 2, a front cover 10, and a holding member 3. Nor does Applicant dispute that the front end of the holding member 3 has forms a first stop surface which moves and engages with a second stop surface arranged on a rear end of the front cover 10. Indeed, Fig. 4 of SLAMA clearly shows such contact. However, it is clear that the second stop surface (i.e., the one arranged on the rear end of the front cover 10) is not axially retained to a front portion of the body 2. To the contrary, this surface is arranged on a rear end of the front cover 10 and not the body 2. Nor is this surface properly characterized as axially retained. As the Examiner will note from Fig. 3, rotation of the front cover 10 will cause this surface to move axially. A surface which can move axially and which is arranged on a front cover 10 simply cannot be characterized as a surface that is axially retained to a front portion of the body. It is also clear that SLAMA fails to disclose, or even suggest, a main spring disposed between the front and rear ends of the holding member. Indeed, the Examiner has acknowledged as much in the instant Office Action. It is further also clear that SLAMA fails to disclose, or even suggest, a back cap configured to move the holding member to a retracted position and/or a second spring disposed between the rear end of the holding member and a surface of the back cap. Indeed, the Examiner

P23568.A08

has failed to identify any of these features in SLAMA. Nor can the Examiner do so from a fair review of the figures of SLAMA. As the Examiner will note from Figs. 1-5, the body 2 has a closed rear end and merely utilizes a single spring 4.

With regard to SCHRAGA, Applicant acknowledges that SCHRAGA discloses a lancet device (see e.g., Fig. 16) which utilizes, among other things, a body, a front cover, a holding member, two springs and a back cap. However, it is clear that the second stop surface 28, while being non-movably coupled to the body and extending inwardly therefrom (see Fig. 2), is not arranged between the first stop surface and the skin engaging end. It is also clear that SCHRAGA fails to disclose, or even suggest, the combination of a first stop surface coupled to or arranged on a front portion of the holding member and a second stop surface axially retained to a front portion of the body. To the contrary, Fig. 2 shows the second stop surface 28 arranged at a rear portion of the body and not on a front portion of the body. Moreover, the first stop surface, while clearly coupled to the holding member 32, is not coupled to or arranged on a front portion of the holding member 32. To the contrary, Fig. 2 shows a first stop surface coupled to member 33 which is arranged on the rear portion of the holding member 32.

CONCLUSION

Reconsideration of the Final Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
S. SCHRAGA



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